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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,369	12/12/2003	John Frederick Ackerman	130014/11922 (21635-0117)	1808
31450	7590	08/10/2005	EXAMINER	
MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166			BAREFORD, KATHERINE A	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/735,369

Applicant(s)

ACKERMAN ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, ~~the proposed amendment(s):~~ a) ☐ ~~will not be entered, or~~ b) ☐ ~~will be entered~~ and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary, and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

b Continuation of 11. does NOT place the application in condition for allowance because: (1) as to the double patenting rejection (a) as to the selection from the list of elements rather than the first and second subgroups, the Examiner has reviewed applicant's arguments, however the rejection is maintained. The allowed selection from the given list of '588 would provide for the selection of elements that are the same as that given by applicant's selection from the listed subgroups. As a result, the elements used can be the same, thus meeting the requirements of the claim. (b) as to the traversal of the of indication of the use of yttria stabilized zirconia and nickel base superalloy as "well known", the Examiner notes that this traversal was not made in the next reply after the assertion was made (it was first made in the Office Action of 3/28/05). However, it is also noted that the previously cited reference to Ackerman et al (US 2003/0059633) teaches that the use of yttria stabilized ceramics is well known (see Paragraph [0028]) and that the use of nickel based superalloy substrate articles is well known (Paragraph [0020]) in the thermal spraying art. The previously cited reference to Subramanian et al (US 6677064) also teach these features, see column 4, lines 5-10 and 45-60. (c) as to the arguments as to the atomic ratio, the Examiner has reviewed these arguments, however, the rejection is maintained. As discussed in the Final Rejection, while a parameter must be recognized as a result effective variable before determination of the optimum or workable ranges, one of ordinary skill in the art would clearly recognize that from the list of possible mixtures of materials present by '588 in the claims, that routine experimentation would be needed to indicate which mixtures provided desirable sintering inhibition. As discussed by '588 in column 8, lines 35-45, mixtures can be used "as long as the reaction products meet the other requirements set forth herein". As a result of performing this routine experimentation, mixtures within the claimed ratio would be determined. Thus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Applicant has made no showing in the amendment or in the specification as filed that the claimed ranges are critical. Applicant has provided no arguments as to why this reasoning is incorrect. (2) as to the 35 USC 103 rejection using Ackerman, (a) as to the selection from the list of elements rather than the first and second subgroups, the Examiner has reviewed applicant's arguments, however the rejection is maintained. The allowed selection from the given list of Ackerman would provide for the selection of elements that are the same as that given by applicant's selection from the listed subgroups. As a result, the elements used can be the same, thus meeting the requirements of the claim. (b) as to the arguments as to the atomic ratio, the Examiner has reviewed these arguments, however, the rejection is maintained. As discussed in the Final Rejection, while a parameter must be recognized as a result effective variable before determination of the optimum or workable ranges, one of ordinary skill in the art would clearly recognize that from the list of possible mixtures of materials present by Ackerman, that routine experimentation would be needed to indicate which mixtures provided desirable sintering inhibition. As discussed by Ackerman in paragraph [0034], mixtures can be used "as long as the reaction products meet the other requirements set forth herein". As a result of performing this routine experimentation, mixtures within the claimed ratio would be determined. Thus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Applicant has made no showing in the amendment or in the specification as filed that the claimed ranges are critical. (3) as to the 35 USC 103 rejection using Subramanian, (a) as to the selection from the list of elements rather than the first and second subgroups, the Examiner has reviewed applicant's arguments, however the rejection is maintained. The allowed selection from the given list of Subramanian would provide for the selection of elements that are the same as that given by applicant's selection from the listed subgroups. As a result, the elements used can be the same, thus meeting the requirements of the claim. (b) as to the arguments as to the atomic ratio, the Examiner has reviewed these arguments, however, the rejection is maintained. As discussed in the Final Rejection, while a parameter must be recognized as a result effective variable before determination of the optimum or workable ranges, one of ordinary skill in the art would clearly recognize that from the list of possible mixtures of materials present by Subramanian, that routine experimentation would be needed to indicate which mixtures provided desirable sintering inhibition. As discussed by Subramanian at column 7, lines 10-20, materials are advantageously selected based on their phase stability and possible reaction products, which are desired to have a low tendency to sinter. As a result of performing this routine experimentation, mixtures within the claimed ratio would be determined. Thus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Applicant has made no showing in the amendment or in the specification as filed that the claimed ranges are critical.

Continuation of 13. Other: Please note the correct serial number of this case is 10/735,369. Applicant's cover sheet and heading of each page used the incorrect serial number 10/753,369.

Kath. L. B./S
KATHERINE BAREFORD
PRIMARY EXAMINER